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| MARTIN & ASSOCIATES, LLC | | | DAGOSTA, STEPHEN M | |
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

DEC 19 2005

Technology Center 2600

Application Number: 09/633,766
Filing Date: August 07, 2000
Appellant(s): BATES ET AL.

Derek Martin, #36,595
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7-19-2004 appealing from the Office action mailed 4-15-2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendment after Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-19 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

| | | |
|-----------|-------------------|-----------|
| 5,978,689 | Tuoriniemi et al. | 11-2-1999 |
| 6,199,076 | Logan et al. | 3-6-2001 |
| 5,152,012 | Schwob | 9-29-1992 |

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

a) The primary examiner, along with the Appeals Conference attendees, acknowledged that claims 3-5 and 13-15 contain novel material and would be allowable if amended to claims 1 and 12 respectively. The examiner contacted appellant's attorney regarding this possible amendment to avoid the case going to the Appeal Board, but the appellant declined. Note: they have never amended a claim during prosecution.

b) Claims 1-2, 6-9, 12 and 16-19 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office Action dated 4-15-2004 (the examiner notes that the delay in receiving the examiner's answer was based on the EDAN system).

(11) *Response to Argument*

a. **Issue 1** (page 5): The appellant argues that claims 1 and 12 are not taught by the prior art of record. The appellant makes several attempts to show that the primary examiner's cited art does not teach (or combine) to properly reject these claims. The appellant also claims hindsight is used. The primary examiner disagrees since he believes his prior art teaches the claimed limitations and provides reasonable motivation (as derived only from the cited prior art).

Claims 1 and 12 are written in a much broader fashion than allowed claims 10-11 and 20-22, hence the primary examiner believes that the prior art reads on the claims.

To summarize: Tuoriniemi teaches a portable digital satellite receiver which receives radio broadcasts and program information corresponding to a selected channel **but is silent on** displaying information regarding at least one channel not selected wherein the displayed information is derived from the identifying information for the at least one channel that is not selected.

The primary examiner must broadly interpret all claims presented before him. As such, Logan was added to remedy Tuoriniemi's failings since he discloses an audio program player (which is described as being used to output radio broadcasts, see C1, L10-63) whereby a host server (eg. broadcast station) transmits data to users (eg. listeners) and provides means for said user to jump to audio files (eg. channels/stations) which are described but not selected (C2, L38-43).

"Logan teaches an audio program player with dynamic program selection (title, abstract) that allows a user to selectively jump to other audio files which are described but not selected (C2, L55 to C3-L11, specifically C3, L4-1 1 which describes "skimming" through subjects/channels and jumping to one desired)".

- Logan provides motivation as to why the primary examiner combined these pieces of art, since "..it is an object of the present invention to provide easy access to rich selection of audio programming and to allow the listener to dynamically and interactively locate and select desired programming from the available collection in an easy and intuitive way..." (C1, L64 to C2, L1). Hence the examiner has used only the references, and not hindsight, for this proper combination.
- The primary examiner also points to Logan's teachings of downloading a "schedule" that can be viewed and played in the future by the user (C27, L15-40), which again reads on the claims.

Furthermore, Schwob teaches a radio broadcast receiver with a significant amount of data that is displayed but was not selected by the user for display (eg. date, Sleep, Preset station #, Frequency, Station, City, State, Type of Music, see figure 3):

"Schwob teaches a radio broadcast receiver (C1, L15-20 and C2, L55-67 and figures 1-3 and C3, L53-68 to C4, L1-13) that has a screen which is "larger than normal" since it has the capacity/size to display many different pieces of information at the same time (ie. Alarm, date, Sleep, Preset Station #, Frequency, Station, City, State and Type of music - ref. figure 3 for these). Hence one skilled in the art would use a similarly sized display combined with the disclosures of Tuoriniemi, and Schwob also discloses this device as being used on a TV receiver as well".

It would have been obvious to one skilled in the art at the time of the invention to modify Tuoriniemi, such that the system displays at least one channel that is not selected, to provide means for a user to simultaneously Listen to one station/song while viewing if there is another station/song they prefer to switch to”.

Therefore the primary examiner believes that these audio outputting devices and their combined capabilities read on the claim. Since the appellant's claim does not provide any other limitation as to how or why the non-selected radio station is displayed, the primary examiner believes he has met his burden and properly rejected the claim.

Lastly, the examiner notes that the appellant has attacked the references individually where the rejections are based on combinations of references – which is not proper. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The appellant argues Logan's audio player is not a radio receiver, which is not fully accurate since it can play Internet radio stations, but the examiner has only taken it's concept of allowing a user to view non-selected audio files/channels as that which is combined with Tuoriniemi's radio receiver. Hence the appellant should not be arguing that a radio receiver is not taught by Logan (when Tuoriniemi disclosed this very fact).

b) The appellant argues claims 7 and 17 are allowable over the prior art. The primary examiner disagrees since the cited art teaches claim 7/17. Specifically, it states:

“As per claims 7 and 17, Tuoriniemi teaches claim 1 wherein the displayed information includes a title for the radio program (C13, L52-54 teaches radiotext that identifies music, name of performer, change of program, etc. which encompasses title of radio program)”.

c) The appellant argues claims 8 and 18 are allowable over the prior art. The primary examiner disagrees since the cited art teaches claim 8/18. Specifically, it states:

"Alexander teaches a television display which shows how long a program lasts (figure 1 shows "PRIME TIME LIVE" with start/end times above it). Since one watches TV and shows last for 30 minutes, it is prudent to show start/end times. Radio is not watched and songs are typically much shorter, hence one skilled in the art would more likely choose to show time remaining for the program/song. Logan teaches a system that supports radio broadcast programs whereby the scheduled duration of each program segment may be displayed, along with the elapsed time remaining to be played in the currently playing segment, to enable the user to more easily determine when to skip the remainder of the currently playing segment (C1, L10-30 and C12, L35-57).

It would have been obvious to one skilled in the art at the time of the invention to modify Tuoriniemi, such that the displayed information includes time remaining, to provide means for the user to decide - based on time remaining - whether to keep listening to the station/song or change the channel."

The primary examiner clearly provides prior art and motivational teachings to arrive at the claimed limitations. Hence he believes that one skilled would combine the art in a manner that reads on the claims.

d) The appellant argues that claims 9 and 19 are allowable over the prior art. The primary examiner disagrees since the cited art teaches claim 9/19. Specifically, it states:

"As per claims 9 and 19, Tuoriniemi teaches claim 1 wherein the displayed information includes artist and song title (C13, L52-54 teaches radiotext that identifies music, name of performer, change of program, etc. which encompasses song title)"

Firstly, the prior art does teach displaying the artist's name (eg. name of performer above) and one skilled would modify the display to include song title since it provides considerable additional information (eg. music, change of program, etc.).

e) **Issue 2** (page 13): The appellant argues that claim 2 is allowable over the prior art. The primary examiner disagrees since the cited art teaches claim 2. Specifically, it states:

"As per claim 2, Tuoriniemi teaches claim 1 but is silent on further comprising memory coupled to the satellite radio processor, the memory containing at least one channel preset.

While a radio receiver is known to have memory presets, Shigematsu teaches a digital broadcast receiver (title) that supports Digital Satellite Radio (C1, L10-20) with a display that has selection buttons to recall channel presets from memory (figure 7, #52). The examiner notes that Shigematsu teaches a more stationary receiver while a more mobile receiver is taught by Tuoriniemi.

It would have been obvious to one skilled in the art at the time of the invention to modify Tuoriniemi, such that memory contains at least one preset, to provide means for a user to quickly select their preferred stations from all available stations.

The prior art clearly rejects the claim properly.

f) **Issue 3** (page 13): The primary examiner now objects to these claims (ie. 3-4 and 13-14) as containing novel material.

g) **Issue 4** (page 16): The primary examiner now objects to these claims (ie. 5 and 15) as containing novel material.

h) The appellant correctly points out that the primary examiner erred when he stated in the previous non-final office action that claims 10-11 and 20-22 were "previously allowed". These claims were allowed for the first time in that office action. The examiner apologizes for this oversight.

i) As a final point, the examiner contacted the applicant's attorney regarding several phrases in the brief that he (and the appeal conferees) believed were "flippant" and "inflammatory", such as:

- "this position is just plain silly",
- "it is unbelievable the Examiner did not clean up this messy part",
- "Oh boy, here we go again"
- "the Examiner's rejections reek of hindsight".

These phrases are not proper for official documents making their way to the USPTO (and especially those destined for the Appeals Board).

Furthermore, Page 19 of the Appeal Brief states that the "Examiner has not met the appellant's challenge", yet the examiner believes his office action(s) properly reject the claims and provides sufficient information/motivation for the appellant to understand said examiner's position (note: just because the appellant disagrees does not give them the right to impugn the examiner. It is the Board's responsibility to decide matters when there is no clear path to agreement).

Respectfully submitted,

Stephen D'Agosta
Primary Examiner
November 22, 2005

N.D.A.
11-22-05

Conferees:
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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARY LEE BATES, ERIC JOHN NELSON
and JOHN MATTHEW SANTOSUOSO

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PAT & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Application No. 09/633,766

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on October 18, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

Upon review of the Examiner's Answer mailed May 6, 2005, it appears that the section "Status of Amendment After Final" is missing from the Examiner Answer. According to the Manual of Patent Examining Procedure (MPEP) § 1208 (8th ed., August 2001), ¶ 12.57. Appropriate correction is required. Also, on page 8, it appears that no appeal conference has been conducted. According to the Manual of Patent Examining Procedure (MPEP) § 1208 (8th ed., August

2001), when an appeal conference has been held, the appeal conference participants, including the examiner charged with the preparation of the Examiner's Answer, must identify themselves as the conferees, along with placing their initials next to their name. This procedure has not been completely followed, thus raising the question of whether or not an appeal conference was held.

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- 1) submit a new Examiner's Answer which includes the missing section as required by MPEP § 1208, ¶ 12.57;
- 2) taking corrective action regarding the appeal conference, written notification of the action taken, and for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 

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